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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,669	01/10/2002	Satoshi Fujioka	Q68022	2951

7590 04/23/2004

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2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

TRAN, HUAN HUU

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,669

Applicant(s)

FUJIOKA, SATOSHI

Examiner

Huan H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-27 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1, 12/1, 27/1; 2, 4/2, 22/2, 5/; 6-11, 13-15, 16-20, 21, 23, 24, 25, 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 12/1, 21/1, 27/1, 23 are indefinite since it does not define any structure to support the functional wherein limitations. See In re MASON, 114 USPQ 127 (CCPA 1957) (Functional statement cannot serve to distinguish claims, which are not process claims, from reference since it does not define any structure).

The sucking unit recited in the claims is a flat plate 215 having a plurality of ports 215a-c as described in the specification (see Figs 11 and 12 and the detailed description thereof). As such, the suction unit cannot support the functional wherein limitation.

Claim 2, 4/2, 5/2, 22/2 are indefinite for lack of recitation in the claim of sufficient structure to support the opening and closing of the shutter.

Claim 6, "the suction means" lacks antecedent basis. Furthermore, the suction unit is described in the specification as a flat plate 215 having a plurality of ports. As such, it cannot be seen how it can have a sucking force.

Claim 13, the definition of the "suction unit" is inconsistent with that of the suction unit comprising a flat plate 215 with a plurality of ports as defined in the specification.

Claim 16 and dependent claims thereof are indefinite for lack of recitation in the claim of structure to support the functional wherein clauses. See In re MASON, 114 USPQ 127 (CCPA 1957) (Functional statement cannot serve to distinguish claims, which are not process claims, from reference since it does not define any structure). Specifically, the recited

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"plate" and "vacuum" do not provide structural support for the recited wherein clause.

Claim 19 is indefinite for lack of recitation in the claim of sufficient structure to support the limitation "wherein the shutter opens and closes the plurality of ports by relatively moving with respect to the plate"

Claims 24 and 25, "the suction means" lacks antecedent basis. Furthermore, the suction unit is described in the specification as a flat plate 215 having a plurality of ports. As such, it cannot be seen how it can have a sucking force.

Claim 26, "the suction means" lacks antecedent basis. Moreover, the definition of the suction unit in the claim is different from that of the suction unit 215 given in the specification.

MPEP 2173.05(g) states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). (Emphasis added).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (Emphasis added).

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In this respect, it is submitted that the functional language found in the claims is not used in association with an element to define a particular capability or purpose that is served by the recited element.

Allowable Subject Matter

3. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (571) 272-2261. The examiner can normally be reached on M-F with Monday off, from 7:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huan H. Tran
Primary Examiner
Art Unit 2861

hht

04/16/04